



**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS**

In re Application of: Ray Whitney) Date: July 24, 2008
Serial N°: 09/921,375) Group Art Unit: 2642
Filed: 08/02/2001) Examiner: My Xuan Nguyen
For: Digital, Wireless PC/PCS Modem)

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CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450.

Terri Takos
Name:

7/25/08
Date

REPLY TO EXAMINER'S ANSWER

Hon. Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

This is a reply to the Answer received on 09/16/2005.

In conjunction with the arguments put forth in the Appeal Brief, and as previously described, the present invention includes a number of features that are unanticipated in the above mentioned references.

First, Applicant wishes to indicate that the present invention is a continuation in part of U.S. Serial No. 09/273482, filed on 03/22/1999. As such, those references cited by the Examiner for Tilford et al. and Hall et al. were issued and published after the priority date

of the present application, and as such are not "prior art" for purposes of rejections under 35 U.S.C. 103.

Assuming, arguendo, that these references are appropriate for analysis, the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. The basic rules relating to rejections based on combinations of patents are stated by the Court of Appeals for the Federal Circuit, in Princeton Biochemicals, Inc. v Beckman Coulter, June 9, 2005. 411 F. 3d 1332, 75 U.S.P.Q.2d 1051.

"Section 103 of title 35 of the United States Code states:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. [35 U.S.C. § 103(a) (2000)].

The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations. See Graham v. John Deere Co. of Kansas." Princeton at 1337.

The Court is not reciting new law, but rather provides a detailed explanation of the law as it has been for many years. It is stated in Princeton, at 1337,

There is no dispute that the references introduced at trial disclosed every element in claim 32. Guzman admitted this in his testimony at trial. Thus, aside from the relevance of the asserted references, the only disputed issue at trial, and asserted on appeal, was whether there was motivation to combine the elements already present in the prior art. As this court outlined in Ruiz v. A.B. Chance Co., 357 F.3d. 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envil Designs, Ltd. V. Union Oil Co., 713 F.2d. 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are

combinations of old elements"). Id.

The motivation to combine must be found in the prior art, not in the invention of the patent application. The court further states at 1337,

"The 'as a whole' instruction in title 35 prevents evaluation of the invention part by part." Ruiz, 375 F.3d. at 1275. "Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. Id. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result—often the essence of invention. Id.

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. Id. This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. Id. In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998)."

The words to note in particular are "**section 103 requires some suggestion or motivation, before the invention itself, to make the new combination**". (Emphasis added.) Evaluation of the invention part by part is prevented by title 35. The examiner does not allege that there was a recognition of the shortcomings of the prior structures, or that motivation to make the combinations as described in the claims, can be found in any of the references identified by the examiner. The examiner avoids the issue by stating that the combination was obvious, and that if one wanted to obtain the benefits taught in the present patent, they would combine features found in the patents. The examiner's position is in direct conflict with the law, as evident from the Princeton case. The examiner must

show that the **motivation** to obtain the benefits that flow from the combination is found in the references. While the nature of a problem may in some circumstances supply a motivation to combine prior art references the patents relied upon by the Examiner to modify Shepard et al., are from different, unrelated technologies. "A reference is appropriate prior art if within the field of the inventor's endeavor." Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449 (Fed. Cir. 1986).

The examiner's attention is further invited to Princeton, at 1338, wherein the court establishes that the suggestion or motivation to modify must be found in the cited references.

"As discussed, simply identifying all of the elements in a claim in the prior art does not render a claim obvious. Ruiz, 357 F.3d at 1275. Instead section 103 requires some suggestion or motivation in the prior art to make the new combination. Rouffet, 149 F.3d at 1355-56. A suggestion or motivation to modify prior art teachings may appear in the content of the public prior art, in the nature of the problem addressed by the invention, or even in the knowledge of one of ordinary skill in the art. 04-1493 1204-1493 12, 225 F.3d 1349, 1356 (Fed. Cir. 2000).

....
[T]he combination is obvious. Every one of the individual ideas is obvious. And the combination is absolutely obvious. Everybody in all of the related fields in all of the related technologies is doing those kinds of things...The entire package taken together is obvious."

Princeton at 1339, provides the following illuminating discussion:

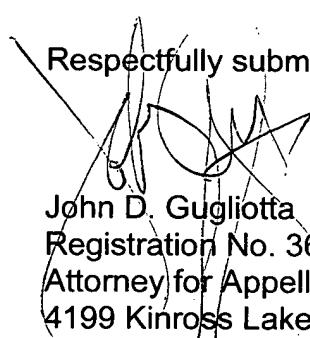
"A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." citing In re GPAC Inc., 57 F.3d 1573, 1578 (Fed. Cir. 1995.) If a reference's disclosure relates to the same problem as the claimed invention, "that fact supports use of that reference in an obviousness rejection." In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992)."

Once again, we see that the standards for a rejection of a claim based on a

combination of references, are not met by the rejection in the present case. The prior art references do not address the same problems in the same way

With all due respect to the examiner, it appears to be obvious that the examiner's rejections fall extremely short of the Black Letter Law, as specified in Princeton and in numerous other court decisions, as for example, those cited in Princeton. Solutions to problems may seem obvious after the problem is recognized, but it often takes creative genius to recognize the problem.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

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